

REMARKS

In the Office Action dated December 14, 2004, the drawings were objected to for failing to show every feature of the claimed invention, claims 1-10 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,118,469 to Hosomi, and claims 1-10 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 7-10 of Applicants' copending Application No. 09/966,124.

Applicants have amended the specification to reflect issuance of copending Application No. 09/966,124 as U.S. Patent No. 6,871,815 on March 29, 2005.

Applicants submit a terminal disclaimer herewith in response to the obviousness-type double patenting rejection.

Claims 9 and 10 have been amended to remove the "arm" feature. Amended claims 9 and 10 now recite a "conductive contact element", an embodiment of which is described in the specification as a "compression spring 2019" and is shown in Fig. 15. (See paragraph [0079] of the specification.)

Applicants have added new claims 11-22, each of which ultimately depends from one of claims 1, 4, and 8. The novelty of these new claims rests in at least the novel areas of claims 1, 4, and 8 for the reasons set forth below.

Turning to the obviousness rejections, the MPEP sets forth the following standard for establishing a *prima facie* case of obviousness:

ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must

both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP § 2142. Claims 1-10 were rejected as being obvious over the Hosomi reference in view of the knowledge of one skilled in the art. However, as discussed below, the Hosomi reference does not establish a *prima facie* case of obviousness over claims 1-10 because the Hosomi reference either teaches away from the claimed invention or it does not teach each and every element of the claimed invention.

Claim 1 in the present application is directed towards a method of grounding a dispenser. This method includes connecting a low impedance path to "elements internal to the dispenser" and to a surface contact spring which is "adapted to contact an external mounting surface when the dispenser is affixed to the external mounting surface". The method further includes the limitation of "discharging static electrical charge accumulated on the elements to the external mounting surface through the low impedance path and the surface contact spring."

In contrast, Hosomi discloses grounding internal elements of a thermal printer through a ground trace on the controlling circuit of the printer. The ground trace is in turn connected to an external earth ground terminal. See Col. 8, l. 60 – Col. 9, l. 8. Hosomi thus teaches that static electricity build-up on the roller is discharged through the circuit board controlling the print function to the external ground terminal, which is electrically conducting and provided specifically as an earth ground.

By teaching use of an external earth ground terminal, the Hosomi reference teaches away from the invention of claim 1. Specifically, the Hosomi reference teaches grounding the thermal printer to an electrically conductive external earth ground terminal. This teaching conforms with the accepted grounding scheme of discharging excess electrical charge to a conducting earth ground, if such is available, or to some other conducting low electrical potential terminal, which is generally associated with the external power source of the electrical device. Nothing in the Hosomi reference teaches

that static electrical charge built up on internal elements of the printer should be discharged in any way other than by commonly accepted grounding schemes.

The grounding scheme of claim 1, on the other hand, discharges static electrical charge built up on internal elements of the dispenser to the surface on which the dispenser is mounted. Further, the surface to which the dispenser is mounted is not the equivalent of an external earth ground terminal because the mounting surface need have no connection to earth ground. The invention of claim 1 is therefore suitable for mounting on *any* available surface. Thus, the Hosomi reference does not establish a *prima facie* case of obviousness over claim 1.

Claims 2 and 3 each ultimately depend from claim 1. For the same reasons stated above in reference to claim 1, the Hosomi reference does not establish a *prima facie* case of obviousness over claims 2 and 3.

Amended claim 4 includes the limitation that the surface contact spring is "adapted to directly contact a mounting surface external to the dispenser when the dispenser is affixed to the mounting surface". The Hosomi reference does not teach this limitation. Instead, the Hosomi reference teaches that spring 42 is employed to bias the arm 51 against the roller 18a. The spring 42 does not directly contact the external surface to which the printer is mounted. For this reason, the Hosomi reference does not teach every element of amended claim 4 and therefore does not establish a *prima facie* case of obviousness over amended claim 4.

Claims 5-7 each ultimately depend from amended claim 4. For the same reasons stated above in reference to amended claim 4, the Hosomi reference does not establish a *prima facie* case of obviousness over claims 5-7.

Claim 8 includes the limitation of a conductive path that is adapted "to discharge static electricity accumulated on the at least one roller to the support surface." As discussed above in relation to claim 1, the Hosomi reference does not disclose or teach discharging built up static electrical charge to the support surface. Rather, the Hosomi

reference teaches discharging static electrical charge using commonly accepted grounding schemes. The Hosomi reference therefore does not establish a *prima facie* case of obviousness over claim 8.

Claims 9 and 10 each ultimately depend from claim 8. For the same reasons stated above in reference to claim 8, the Hosomi reference does not establish a *prima facie* case of obviousness over claims 9 and 10.

For the above reasons, reconsideration of the rejections is requested.

Respectfully submitted,

FULBRIGHT & JAWORSKI L.L.P.

DATE: April 13, 2005 By: 

David M. Morse
Reg. No. 50,505

Fulbright & Jaworski L.L.P.
865 South Figueroa Street
Twenty-Ninth Floor
Los Angeles, California 90017-2576
Telephone No.: (213) 892-9200
Facsimile No.: (213) 680-4518